# Rolls-Royce Plc & Anor v Saujana Hotel Sdn Bhd (Pendaftar Cap Dagangan Malaysia, interested party) and another suit

HIGH COURT (KUALA LUMPUR) — ORIGINATING SUMMONS NOS WA-24IP-16–07 OF 2018 AND WA-24IP-17–07 OF 2018
LIM CHONG FONG J
27 JUNE 2019

*Trade Marks — Registration — Opposition — Whether two marks were dissimilar visually — Whether use of impugned mark would likely deceive or cause confusion to trade and public — Whether it was necessary for defendant to show prior use when there was cogent evidence of use of plaintiffs' mark — Whether impugned mark distinctive with defendant's good*

These were appeals against the decision of the Registrar of Trade Marks who dismissed the opposition against the registration of trademarks for branded merchandise. The first plaintiff was the registered proprietor of the mark in Malaysia and the mark has also been registered in many countries around the world. The defendant had on 20 September 2001 filed for the registration of the impugned mark in Class 25 and Class 18. The plaintiffs submitted that the first plaintiff had established substantial reputation and goodwill in Malaysia and around the world and has been extensively and continuously advertising and promoting its goods and services under the mark in Malaysia and throughout the world. The plaintiffs corporate websites prominently feature the mark and are/were accessible by users and members of the trade and public around the world included those in Malaysia, as a result, the plaintiffs hadacquired proprietary rights to the mark and are jointly entitled to the exclusive use of the mark and any mark which is confusingly similar thereto including the impugned mark. The defendant submitted that: (a) the defendant was a bona fide proprietor of the impugned mark and has been using the same since 2001. The device or design of the impugned mark were created by the defendant to symbolise the building concept known as Rumah Peranakan and the diamond shape or rhombus box around the letters RP to symbolise the Peranakan tile concept, further the copyright in the impugned mark is owned by the defendant and that copyright subsists and resides at all material times with the defendant; and (b) the defendant contended that the impugned mark was inherently and/or factually distinctive and would thus not cause confusion or deception to the public.

**Held**, dismissing the appeals with costs of RM5,000 for each appeal subject to allocator fee:

(1) Both of them are basically logos. They are not pronounceable words orally. In the court's objective opinion, they are significantly dissimilar visually. The difference was even more conspicuous if the coloured version of the defendant's impugned mark was compared with the plaintiff's mark. They would not objectively be resembling each other even viewed through imperfect impression or recollection the court therefore, find and hold that the learned registrar had erred in fact in concluding that the defendant's impugned mark looked confusingly similar or nearly resembled the plaintiffs' mark as a whole. They are neither identical nor so nearly resembling each other (see paras 28–29).

(2) There was no cogent evidence that these goods were specifically sold in Malaysia at the relevant date of 20 September 2001 when the defendant's applications were filed for registration. The required cogency necessitated the plaintiffs to substantiate their sales figures as averred in the plaintiffs' affidavits with the relevant sales invoices or delivery notes but this was not done here. In the absence of use of the plaintiffs' mark as aforesaid, it is unnecessary for the defendant to establish evidence of its prior use of the defendant's impugned mark contrary to the plaintiffs' contention of such necessity to so prove usage (see paras 32 & 34).

(3) The goods involved are branded merchandise. The court was satisfied that the customers are discerning ones who were well versed with the respective marks of the parties. The trade channel of these goods was also obviously different. The court did not find that the learned registrar had erred because there was no real tangible danger of deception or confusion caused by the co-existence of the defendant's impugned mark and the plaintiff's mark (see paras 35–36).

(4) The court had no doubt that the impugned mark was distinctive pursuant to s 10(1)(e) and (2) of the TMA. It was sufficient as long as the applicant was able to satisfy the registrar that the trademark is registrable within any limbs in s 10 of the TMA. The court was satisfied that the defendant through its long and continuous use of its impugned mark had acquired substantial goodwill and reputation, as a result the impugned mark was also factually distinctive which associated the goods with the defendant (see para 41).

**[Bahasa Malaysia summary**

Ini merupakan rayuan-rayuan terhadap keputusan Pendaftar Cap Dagangan yang mengetepikan bantahan terhadap pendaftaran cap dagangan untuk barangan berjenama. Plaintif pertama merupakan pemilik perdaftar cap tersebut di Malaysia dan cap tersebut juga telah didaftarkan di beberapa negara di seluruh dunia. Defendan telah pada 20 September 2001 memfailkan agar cap yang dicabar didaftarkan dibawah Kelas 25 dan Kelas 18. Plaintif menghujahkan bahawa plaintif pertama mempunyai nama baik di Malaysia

dan di serata dunia dan mengiklankan dan mempromosi barangan dan perkhidmatan mereka di bawah cap tersebut di Malaysia dan diseluruh dunia. Laman web korporat plaintif memaparkan cap tersebut dengan jelas dan boleh diakses oleh pengguna dan ahli bidang perniagaan tersebut dan awam seluruh dunia termasuk mereka yang berada di Malaysia, oleh itu, plaintif telah mendapatkan hak tuan punya terhadap cap tersebut dan turut berhak kepada penggunaan eksklusif cap tersebut dan apa-apa cap yang sama yang boleh mengelirukan termasuklah cap yang dicabar. Defendan menghujahkan bahawa: (a) defendan merupakan tuan punya bona fide cap yang dicabar dan telah meggunakannya sejak tahun 2001. Rekaan cap yang dicabar tersebut telah direka oleh defendan untuk melambangkan konsep bangunan Rumah Peranakan dan bentuk potongan wajik yang mengelilingi huruf RP melambangkan konsep jubin peranakan, lanjutan itu, hak cipta cap tersebut dimilik oleh defendan; dan (b) ianya dihujahkan bahawa cap yang dicabar tersebut adalah berbeza secara fakta berbeza dan oleh itu tidak akan menyebabkan kekeliruan atau penipuan kepada orang awam.

**Diputuskan**, mengetepikan rayuan dengan kos RM5,000 untuk setiap rayuan tertakluk kepada fi alokatur:

(1) Kedua-duanya adalah lambang. Ianya bukan perkataan yang boleh disebut secara lisan. Dalam pendapat objektif mahkamah, mereka ada berbeza secara visual. Perbezaan adalah lebih jelas apabila versi berwarna cap defendan yang dicabar dibandingkan dengan cap plaintif. Ianya tidak akan secara objektif menyerupai satu sama lain walaupun dilihat melalui tanggapan dan kenangan, mahkamah oleh itu mendapati dan memutuskan bahawa pendaftar terpelajar terkhilaf dari segi fakta dalam menyimpulkan bahawa cap defendan yang dicabar kelihatan serupa atau menyerupai cap plaintif secara keseluruhannya. Ianya tidak sama ataupun menyerupai satu sama lain (lihat perenggan 28–29).

(2) Tiada keterangan yang meyakinkan bahawa barangan ini secara spesifik di jual di Malaysia pada tarikh 20 September 2001 apabila permohonan defendan untuk pendaftaran difailkan. Keperluan keterangan meyakinkan memerlukan plaintif untuk menampung jumlah jualan seperti mana yang diikrarkan dalam afidavit plaintif dengan invois penjualan yang relevan atau nota penyerahan tetapi perkara ini tidak dilakukan. Dengan ketiadaan keterangan penggunaan cap plaintif seperti mana yang dinyatakan diatas, ianya adalah menjadi satu keperluan untuk defendan membuktikan keterangan penggunaan terdahulunya berkenaan dengan cap defendan yang dicabar bertentangan dengan pengataan plaintif bahawa keperluan untuk membuktikan penggunaan sedemikian (lihat perenggan 32 & 34).

(3) Barangan yang berkenaan adalah barangan berjenama. Mahkamah berpuas hati bahawa penggunanya adalah yang pandai menilai dan mahir

dengan cap pihak-pihak. Saluran perniagaan barangan ini juga berbeza. Mahkamah tidak mendapati bahawa pendaftar terpelajar terkhilaf kerana tiada bahaya penipuan atau kekeliruan yang disebabkan dengan kewujudan cap defendan yang dicabar dan cap plaintif (lihat perenggan 35–36).

(4) Mahkamah tiada keraguan bahawa cap yang dicabar adalah berbeza selaras dengan s 10(1)(e) dan (2) TMA. Ianya adalah memadai selagi mana pemohon mampu untuk memuaskan pendaftar bahawa cap dagangan boleh didaftarkan dibawah mana-mana cabang s 10 TMA. Mahkamah berpuas hati bahawa defendan melalui penggunaan lama dan berterusannya akan cap yang dicabar tersebut telah memperoleh nama baik dan reputasi, oleh itu cap yang dicabar juga adalah berbeza secara fakta berkenaan dengan barangan yang berkait dengannya dengan defendan (lihat perenggan 41).]

**Cases referred to**

*Abercrombie & Fitch Co & Anor v Fashion Factory Outlet KL Sdn Bhd & Ors* [2008] 4 MLJ 127, HC (distd)

*Bata Ltd v Sim Ah Ba @ Sim Teng Khor & Ors (trading as Kheng Aik Trading)* [2006] 6 MLJ 445, CA (refd)

*Buying Systems (Australia) Pty Ltd v Studio SRL* (1995) 30 IPR 517, FC (distd)

*C & A Modes and Anor v C & A (Waterford) Ltd and Ors* [1978] FSR 126 (refd)

*Caitlin Financial Corp NV v CA Seimer (M) Sdn Bhd & Anor* [2001] 3 MLJ 423, HC (refd)

*Chrysler Corporation v Grundy* (2000) 53 IPR 448 (distd)

*Conagra Inc v McCain Foods (Aust) Pty Ltd* (1992) 23 IPR 193, FC (refd)

*Consitex SA v TCL Marketing Sdn Bhd* [2008] 3 MLJ 574; [2008] 8 CLJ 444, HC (refd)

*Dato' Seri Anwar Ibrahim v Tun Dr Mahathir bin Mohamad* [2011] 1 MLJ 145, FC (refd)

*De Cordova v Vick Chemical Co* (1951) 68 RPC 103, PC (refd)

*Dominion Rent A Car Ltd v Budget Rent A Car Systems (1970) Ltd* [1987] 2 NZLR 395, CA (refd)

*Fazaruddin bin Ibrahim v Parkson Corp Sdn Bhd* [1997] 4 MLJ 360, HC (refd)

*Hasbro Inc v Imagination Holdings Pty Ltd* (2005) 66 IPR 636 (distd)

*Hermes SA v ET Swift and Co Pty Ltd* (1984) 2 IPR 432 (distd)

*Ho Tack Sien & Ors v Rotta Research Laboratorium SpA & Anor (Registrar of Trade Marks, intervener)* [2015] 4 MLJ 166; [2015] 4 CLJ 20, FC (refd)

*Hui Kuan Hoe v Societe Des Produits Nestle SA* [2012] 5 MLJ 343, CA (refd)

*Illinois Tool Works, Inc v Pendaftar Cap Dagangan (M)* [2009] 9 MLJ 101, HC (folld)

*Industria De Diseno Textil, SA v Edition Concept Sdn Bhd* [2005] 3 MLJ 347, HC (refd)

*Korea Wallpaper Sdn Bhd v Pendaftar Cap Dagangan* [2019] 7 MLJ 549, HC (refd)
*Lim Yew Sing v Hummel International Sports & Leisure a/s* [1996] 3 MLJ 7, CA (refd)
*Merck KGaA v Leno Marketing (M) Sdn Bhd (Registrar of Trade Marks, interested party)* [2018] 5 MLJ 1, FC (refd)
*Midas Ltd v Mister Figgins Pty Ltd* (1987) 9 IPR 569 (distd)
*Moorgate Tobacco Co Ltd v Philip Morris Ltd and Another* (1984) 56 ALR 193, HC (distd)
*Pentadbir Tanah Daerah Seberang Perai Tengah & Anor v Bagan Serai Housing Estate Sdn Bhd* [2016] 5 MLJ 674; [2016] 8 CLJ 846, CA (refd)
*Radio Corp Pty Ltd v Disney (Mickey Mouse case)* (1937) 57 CLR 448, HC (distd)
*Registered Trade Mark 'Yanx'; Ex parte Amalgamated Tobacco Corporation Ltd, Re* (1951) 1b IPR 504, HC (distd)
*Seven Up Co v OT Ltd* (1947) 75 CLR 203, HC (refd)
*Skyworld Development Sdn Bhd & Anor v Skyworld Holdings Sdn Bhd & Ors* [2019] 9 MLJ 137, HC (refd)
*Tiga Gajah Cho Heng Sdn Bhd v Majuperak Tepung Beras Sdn Bhd* [1997] 4 MLJ 504, HC (refd)
*Tohtonku Sdn Bhd v Superace (M) Sdn Bhd* [1992] 2 MLJ 63, SC (refd)
*Tokai Corporation v DKSH Malaysia Sdn Bhd* [2016] MLJU 621, HC (folld)
*Tong Guan Food Products Pte Ltd v Hoe Huat Hng Foodstuff Pte Ltd* [1991] 2 MLJ 361; [1991] 3 CLJ 2001, CA (refd)
*Walton International Ltd v Yong Teng Hing (b/s Hong Kong Trading Co)* [2011] 5 MLJ 397; [2010] 8 CLJ 802, CA (refd)
*X1R Global Holding Sdn Bhd & Anor v Y-Teq Auto Parts (M) Sdn Bhd* [2016] MLJU 1249, HC (distd)
*Yong Teng Hing b/s Hong Kong Trading Co & Anor v Walton International Ltd* [2012] 6 MLJ 609; [2012] 6 CLJ 337, FC (refd)

**Legislation referred to**

Trade Marks Act 1976 ss 10, 10(1)(e), (2), 14, 14(1)(a), (1)(d), (1)(e), 19, 19(1), 24, 25, 25(1), 70B, 82(2)

*Michael Soo Chow Ming (Wendy Lee Wan Chieh with him) (Shook Lin & Bok) for the plaintiffs.*
*Bahari Yeow Tien Hong (Lim Zhi Jian and Alex Choo Wen Chun with him) (Lee Hishamuddin Allen & Gledhill) for the defendant.*

**Lim Chong Fong J:**

INTRODUCTION

**[1]** These are appeals against the decision of the Registrar of Trade Marks who dismissed the opposition against the registration of Lim Chong Fong J for branded merchandise.

**[2]** The plaintiffs are foreign companies incorporated in the United Kingdom and are related companies. The first plaintiff is the registered proprietor of the following trademarks in Malaysia ('mark'):

| Registration No | Mark | Class | Date of Registration | Status |
|---|---|---|---|---|
| M/031762 | | 12 | 24 June 1959 | Registered |
| MB069061 | | 12 | 26 July 1975 | Registered |
| 99012013 | | 12 | 26 November 1999 | Registered |

**[3]** The mark has also been registered in many countries around the world.

**[4]** The defendant is a local incorporated company and has amongst others on 20 September 2001 filed for registration of the following trademarks:

('impugned mark') in Class 25 via TM No 01012522 and in Class 18 via TM No 01012520 ('applications'). The aforesaid application in Class 25 encompassed cases of leather and leatherboard, travelling bags, rucksacks: imitation leather, key cases (leatherware), pouches of leather for packaging, pocket wallets, purses, shopping bags, umbrellas, and parasols; all included in Class 25 whereas the application in Class 18 encompassed aprons; bibs (not of

paper); clothing of leathers; clothing of imitations of leather; jerseys, neckties, pullovers, jumpers, jerseys, sweaters, tee-shirts, shirts, top coats, singlets, vests, socks, trousers, scarfs, uniforms,; caps, hats, headbands, headgear for wear, visors, top hats; sandals, shoes, slippers; all included in Class 18.

By virtue of s 24 of the Trade Marks Act 1976 ('the TMA') which reads:

> 24 Series of trade marks
>
> (1) Where several trade marks in respect of the same goods or description of goods in a single class or in respect of the same services or description of services in a single class resemble each other in material particulars but differ in respect of —
>
> (a) statements or representation as to the goods or services in respect of which the trade marks are used or proposed to be used;
>
> (b) statements or representations as to number, price, quality or names of places;
>
> (c) other matter which is not distinctive and does not substantially affect the identity of the trade marks; or
>
> (d) colour,
>
> and a person who claims to be the proprietor thereof seeks to register the trade marks, the trade marks may be registered as a series in one registration.
>
> (2) All trade marks registered in a series shall be deemed to be and shall be registered as associated trade marks.

the defendant may use any one or both marks in the course of trade notwithstanding that they are both registered in series in a single registration.

**[5]** The Registrar of Trade Marks ('registrar') as constituted under the TMA has been named as a nominal interested party herein.

SALIENT BACKGROUND FACTS

**[6]** By reason of the applications, the plaintiffs applied to the registrar to oppose the registration of the impugned mark.

**[7]** The registrar on 28 June 2018 dismissed the plaintiffs' opposition ('decisions') with its accompanying grounds of decisions.

**[8]** Consequently the plaintiffs on 26 July 2018 filed their appeal via these Originating Summons No WA-24IP-16–07 of 2018 as well as WA-24IP-17–07 of 2018 ('appeals'). The affidavits that were filed for purposes of these appeals are as follows:

(a) the first plaintiff's affidavits in support affirmed by Philippa Jane Mcleod dated 19 July 2018;

(b) the second plaintiff's affidavits in support affirmed by Bettina May dated 19 July 2018;

(c) the defendant's affidavits in reply affirmed by Lim Li Li dated 27 August 2018;

(d) the first plaintiff's affidavits in reply affirmed by Philippa Jane Mcleod dated 1 October 2018;

(e) the second plaintiff's affidavits in reply affirmed by Dr Jochen Volkmer dated 28 September 2018; and

(f) the defendant's affidavits in reply affirmed by Lim Li Li dated 29 October 2018.

**[9]** By the order of this court dated 28 August 2018, the appeals were directed to be heard together.

**[10]** The appeals therefore came before me and after having read the written submissions filed by the parties, I heard oral arguments of counsel on 21 March 2019, 6 and 9 May 2019. I thereafter adjourned my decision to deliberate on the intricate arguments pursued by counsel.

**[11]** Now having done so, I hereby furnish below my decision together with the supporting grounds of decision.

CONTENTIONS OF COUNSEL

**[12]** In the appeals, the plaintiffs prayed for the following orders:

(1) the decision dated 28 June 2018 of the learned Registrar of Trade Marks, Malaysia ('the learned registrar') in dismissing the plaintiffs' notice of opposition dated 11 April 2008 ('the plaintiffs' notice of opposition') filed against Application No 01012522 for the trademark

in Class 25 ('the defendant's application') be reversed and set aside;

(2) further or alternatively to prayer (1) above, that the plaintiffs' notice of opposition be allowed;

(3) in the event that prayers (1) and/or (2) above is/are granted by this honourable court, the learned registrar be directed to remove and strike off the defendant's application from the list of pending applications;

(4) costs of this application and proceedings before the Registry of Trade Marks, Malaysia be paid by the defendant abovenamed; and

(5) such further and other reliefs as this honourable court deems fit,

and

(1) the decision dated 28 June 2018 of the learned Registrar of Trade Marks, Malaysia ('the learned registrar') in dismissing the plaintiffs' notice of opposition dated 11 April 2008 ('the plaintiffs' notice of opposition') filed against Application No 010125220 for the trademark

in Class 18 ('the defendant's application') be reversed and set aside;

(2) further or alternatively to prayer (1) above, that the plaintiffs' notice of opposition be allowed;

(3) in the event that prayers (1) and/or (2) above is/are granted by this honourable court, the learned registrar be directed to remove and strike off the defendant's application from the list of pending applications;

(4) costs of this application and proceedings before the Registry of Trade Marks, Malaysia be paid by the defendant abovenamed; and

(5) such further and other reliefs as this honourable court deems fit.

**[13]** Mr Michael Soo of counsel for the plaintiffs submitted that the first plaintiff has established substantial reputation and goodwill in Malaysia and around the world and has been extensively and continuously advertising and promoting its goods and services under the mark in Malaysia and throughout the world. The plaintiffs' corporate websites http://www.rolls-royce.com and http://www.rolls-roycemotorcars.com respectively, prominently feature the mark and are or were accessible by users and members of the trade and public around the world including those in or from Malaysia. As the result, the plaintiffs have acquired proprietary rights to the mark and are jointly entitled to the exclusive use of the mark and any mark which is confusingly similar thereto including the impugned mark applied for by the defendant to the exclusion of others.

**[14]** The mark was first used by the first plaintiff in the 1960s on Dart engines which powered the De Havilland Comet and Fokker F 27 aircraft of Malaysia Airlines. The first plaintiff further continued to supply power systems and provide services using the mark to large entities and corporations in Malaysia such as Malaysia Airlines, the Royal Malaysian Air Force, the Royal Malaysian Navy, Petronas, Petronas Carigali, ExxonMobil, Nippon Oil, Shell, Carigali-Triton Operating Company and Talisman. That notwithstanding, the first plaintiff has been using the mark in relation to goods in various classes in addition to that registered in Class 12 including but not limited to Class 18 and Class 25. These goods are available for sale in Malaysia and are commonly ordered for use in local golf tournaments, games exhibitions or events which the plaintiffs' or their local subsidiaries have sponsored in Malaysia.

**[15]** However, the defendant has sought registration of the impugned mark in Class 18 on clothing and Class 25 on leather weal generally.

**[16]** The plaintiffs therefore contended that the registration and/or use of the impugned mark by the defendant in the aforesaid classes would likely deceive or cause confusion to the trade and public and thus contrary to ss 14, 19, 25 and 82(2) of the TMA but the learned registrar has wrongly dismissed the plaintiffs' opposition to the applications of the defendant.

**[17]** Accordingly, the plaintiffs advanced the following grounds in their appeals:

(a) the learned registrar had erred in law and/or in fact in dismissing the plaintiffs' oppositions notwithstanding the fact that the learned registrar had acknowledged that the impugned mark is confusingly similar to or nearly resembles the plaintiffs' mark as a whole;

(b) the learned registrar had erred in law and/or in fact in dismissing the plaintiff's oppositions notwithstanding the fact that the registration of impugned mark by the defendant would be contrary to ss 14 and/or 19 of the Act in that registration and/or use of the impugned mark by the defendant would likely deceive or cause confusion to the trade and public, or would be contrary to law, or it would otherwise not be entitled by any court of law;

(c) the learned registrar had erred in law and/or in fact in failing to give due cognisance to the use of the impugned mark in relation to goods in Classes 18 and 25 by the plaintiffs;

(d) the learned registrar had erred in law and/or in fact in not recognising that the defendant's goods would appeal to or be sought by the same class of consumers as that seeking the plaintiffs' goods;

(e) the learned registrar had erred in law and/or in fact in not recognising that the defendant's goods and the plaintiffs' goods would travel through the same trade channels;

(f) the learned registrar had erred in law and/or in fact in holding that the defendant is the bona fide proprietor of the impugned mark for goods in Classes 18 and 25 under s 25(1) of the Act when the learned registrar had recognised that the defendant did not specifically state their evidence of use and that there was no evidence to show that the defendant was trading in goods in Classes 18 and 25;

(g) the learned registrar had erred in law and/or in fact in failing to give substantial weight and due consideration to the fact that the plaintiffs have acquired goodwill and reputation in its business in relation to the mark;

(h) the learned registrar had erred in law and/or in fact in allowing the defendant's application to proceed to registration when the defendant has failed to discharge the onus of proof that the impugned mark is distinctive of the defendant for goods in Classes 18 and 25 within the meaning of s 10 of the Act;

(i) the learned registrar had erred in law and/or in fact in failing to hold that the registration and/or use of the impugned mark by the defendant would constitute passing-off in common law, contrary to s 82(2) of the Act; and

(j) the learned registrar had erred in law and/or fact in failing to find that the mark is a well-known mark, and hence, ought to have allowed the plaintiffs' opposition under s 14(1)(d) and (1)(e), read with s 70B of the Act.

**[18]** Mr Bahari Yeow of counsel for the defendant retorted that the defendant is the bona fide proprietor of the impugned mark and has been using the same since 2001. The device or design in the impunged mark was created by the defendant to symbolise the building concept known as 'Rumah Peranakan' and the diamond shape or rhombus box around the letters 'RP' to symbolise the Peranakan tile concept. In addition, the copyright in the impugned mark is owned by the defendant and that copyright subsists and resides at all material times with the defendant. Consequently the public associated the impugned mark with the defendant.

**[19]** Contrary to the contentions of the plaintiffs, the defendant contended that the impugned mark is inherently and/or factually distinctive besides also the impugned mark and mark are dissimilar and would not thus cause confusion or deception to the public. There is no real tangible danger or confusion following *Bata Ltd v Sim Ah Ba @ Sim Teng Khor & Ors (trading as*

*Kheng Aik Trading)* [2006] 6 MLJ 445. In addition, the plaintiffs' objection premised on well-known mark is unsubstantiated with cogent evidence as well as that it is speculative as to any damage caused on the plaintiffs by the defendant's usage of the impugned mark.

FINDINGS OF THE COURT

**[20]** My function and powers in relation to these appeals are set out in the Federal Court case of *Merck KGaA v Leno Marketing (M) Sdn Bhd (Registrar of Trade Marks, interested party)* [2018] 5 MLJ 1. Raus Sharif CJ held as follows therein:

> [71] The nature of the jurisdiction exercised by the High Court in determining appeals from tribunals must be determined by reference to the relevant statute itself. The High Court's jurisdiction depends on the nature of the judicial function it exercises (*Citiwall Safety Glass Pte Ltd v Mansource Interior Pte Ltd* [2014] SGCA 61 at para [50]). The correct position was succinctly put in *Eric Chia* at para [12]:
>
> > ... to determine whether or not a particular exercise of power by the High Court is made pursuant to its original jurisdiction, it must necessarily depend on the statutory provision which governs it.
>
> [72] The opposition proceedings before the registrar were brought by the appellant pursuant to s 28 of the TMA. Subsections 28(5), (6) and (7) provide for the right and manner of appeal to the High Court. For completeness of context, s 28 is reproduced herein:
>
> > 28 Opposition to registration
> >
> > (1) Any person may, within the prescribed time from the date of the advertisement of an application for the registration of a trade mark, give notice to the Registrar and applicant of opposition to the registration.
> >
> > (2) The notice shall be given in writing in the prescribed manner and shall include a statement of the grounds of opposition.
> >
> > (3) The applicant shall, within the prescribed time after the receipt of the notice of opposition, send to the Registrar and the opponent a counter-statement, in the prescribed manner, of the grounds for his application, and, if he does not do so, he shall be deemed to have abandoned his application.
> >
> > (3A) If the applicant submits a counter-statement under subsection (3), the opponent and applicant shall file evidence and exhibits in the prescribed manner and within the prescribed time in support of the opposition or the counter-statement, as the case may be, to be adduced in the prescribed manner, and if the opponent or applicant fails to do so, the opposition or application, as the case may be, shall be treated as abandoned. If the applicant files evidence and exhibits under subsection (3A), the opponent may, within the prescribed time, send to the Registrar and applicant evidence in reply to be adduced in the prescribed manner.
> >
> > (4) After considering the evidence and exhibits and after giving the applicant and

the opponent an opportunity of making written submissions, the Registrar shall decide whether

(a) to refuse to register the trade mark;

(b) to register the trade mark absolutely; or

(c) to register the trade mark subject to such conditions, amendments, modifications or limitations as he may think fit.

(5) A decision of the Registrar under subsection (4) is subject to appeal to the Court.

(6) An appeal under this section shall be made in the prescribed manner and the Court shall, if required, hear the parties and the Registrar, and shall make an order determining whether, and subject to what conditions, amendments, modifications or limitations, if any, registration is to be permitted.

(7) On the hearing of an appeal under this section any party may, either in the manner prescribed or by special leave of the Court, bring forward further material for the consideration of the Court but no further grounds of objection to the registration of a trade mark shall be allowed to be taken by the opponent or the Registrar other than those stated by the opponent except by leave of the Court.

(8) Where any further grounds of objection are taken the applicant shall be entitled to withdraw his application without payment of the costs of the opponent on giving notice as prescribed.

(9) In any appeal under this section the court may after hearing the Registrar, permit the trade mark proposed to be registered to be modified in any manner not substantially affecting the identity of the trade mark, but in any such case the trade mark as modified shall be advertised in the prescribed manner before being registered.

(10) If a person giving notice of opposition or an applicant sending a counter-statement after receipt of such a notice, or an appellant, neither resides nor carries on business in Malaysia, the Registrar or the Court may require him to give security for costs of the proceedings relative to the opposition, application or appeal, as the case may be, and in default of such security being duly given, may treat the opposition, application, or appeal, as the case may be, as abandoned.

[73] 'Court' is defined in s 3 of the TMA to mean the High Court. Section 67 provides for the powers of the court in hearing an appeal from the decision of the registrar:

67 Discretionary power

In any appeal from the decision of the Registrar under this Act the Court shall have and exercise the same discretionary powers as are conferred upon the Registrar under this Act.

[74] Section 69 further states that:

69 Appeal from Registrar

Except where expressly given by the provisions of this Act or regulations made there under there shall be no appeal from a decision of the Registrar but the Court, in dealing with any question of the rectification of the Register (including all applications under section 45) shall have power to review any decision of the Registrar relating to the entry in question or the correction sought to be made.

NATURE OF PROCEEDINGS BEFORE THE HIGH COURT

[75] In hearing an appeal from the decision of the registrar under s 28, the High Court does not take cognisance of the matter and determine the dispute at the first instance. On the contrary, the provisions of s 28 indicate that the appeal to the High Court is a rehearing of the original cause before the registrar. The High Court is empowered to examine the merits of the case, correct errors in the registrar's decision, and make such orders as ought to have been made at first instance (*R Rama Chandran*).

[76] Significantly, under s 28(7) of the TMA, the parties may not introduce further materials or additional grounds of objection, not previously raised in the proceedings before the registrar, on appeal to the High Court without the court's leave. These restrictions strongly indicate that the appeal before the High Court is a continuation of the opposition proceedings, where the role of the High Court is to determine the correctness of the registrar's decision based primarily on the materials and grounds then available before the registrar.

**[21]** Additionally in the earlier Court of Appeal case of *Hui Kuan Hoe v Societe Des Produits Nestle SA* [2012] 5 MLJ 343, Linton Albert JCA held as follows:

[38] The registrar's decision to allow the opposition had been made after hearing evidence, taking into account the respondent's mark. His decision entitled to substantial weight: *Solavoid Trade Mark* [1977] RPC 1 at p 28 per Lord Fraser of Tully Belton PC and applied in *Bata Ltd v Sim Ah Ba @ Sim Teng Khor & Ors (trading as Kheng Aik Trading)* [2006] 6 MLJ 445 at p 462.

[39] Unless the registrar has gone clearly wrong, his decision ought not to be interfered with: *Banham v Reddaway* [1927] AC 406 at p 413 (HL) ...

**[22]** That notwithstanding, it is plain that the burden of proof rests on the applicant which is the defendant herein to satisfy the registrar and accordingly this court in these appeals that the impugned mark is registrable under the TMA following the Federal Court case of *Yong Teng Hing b/s Hong Kong Trading Co & Anor v Walton International Ltd* [2012] 6 MLJ 609; [2012] 6 CLJ 337.

**[23]** Since these appeals are essentially a review of the learned registrar's decisions, it is apt to reproduce the salient parts of her grounds of decisions starting off with that concerning the resemblance of the marks, vis:

First, I have to determine whether the applicant's mark is identical or nearly resembling opponent's marks. Looking at the respective trademarks of the applicant and the opponent, I am of the opinion that both marks are not identical. Now, I have to determine whether the applicant's mark is deceptively and/or confusingly similar with the opponent's marks.

Visually, the representation of the applicant's mark and the opponent's mark even though for different letters seems similar especially when the opponent's mark was compared to the black and white version of the applicant's mark. On the aural aspect of the mark, the pronunciation of the applicant's mark especially the black and white version of it can be mistakenly pronounced as RR even though the coloured version of the applicant's mark make it clear that the monogram consists of the letters RP.

Looking at both the applicant's mark and the opponent's mark as a whole, I am of the view that the applicant's mark looks confusingly similar or nearly resembles the opponent's mark. Now I have to determine whether the use of the applicant's mark may cause confusion or deception to the public as to the source of the goods. Similarity per se is acceptable, so long as it does not lead to a likelihood of confusion or deception as stated in *Bata Ltd v Sim Ah Ba @ Sim Teng Khor & Ors*.

It is clearly established in the case of *Rysta Ltd's Application* that the question of whether the use of trademark to be likely to deceive or cause confusion is not an exercise of discretion but is a question of fact. Thus, there is a need to consider the actual circumstances of the case. In this instance, such circumstances will include the nature and use of the goods, the kind of customers that buy the goods, the trade channel in which the goods were sold and the whole impression given by the marks.

The applicant's goods were in Class 18 (and Class 25) namely aprons; bibs (not of paper); clothing of leathers; clothing of imitations of leather; jerseys, neckties, pullovers, jumpers, jerseys, sweaters, tee-shirts, shirts, top coats, singlets, vests, socks, trousers, scarfs, uniforms; caps, hats, headbands, headgear for wear, visors, top hats; sandals, shoes, slippers; all included in Class 18. The opponent's goods were in Class 12 namely vehicle and apparatus for locomotion by land, sea and air, traction and stationery engines and parts and fittings for all the aforesaid goods in Class 12, but not including motor cars, internal combustion engines, gear boxes, transmission systems, suspension systems, chassis and body shells, all being parts of motor cars and parts and fittings for motor cars; all included in Class 12. The opponent also claimed that even though they did not have trademark registration for goods in Class 18 (and Class 25) in Malaysia, they also had also use their trademark for goods in class 18 (and Class 25) in Malaysia. Looking at the goods between Class 18 (and Class 25) and Class 12, the goods are clearly different in nature, use and trade channel. Thus, my decision below will focus more for goods in Class 18 (and Class 25) by both parties since the opponent also claimed for usage in class 18 albeit with no trademark registration in Malaysia for Class 18 (and Class 25).

Based on the claim of usage by the Opponent in Class 18 (and Class 25) goods, it means that the nature and use of the goods is the same. Furthermore, as far as the goods in Class 18 are concerned, it must be noted that these are not the kinds of goods that customers would just pick and then pay at the counter without

reasonably considering things such as the conditions of the goods, the price as well as the trademark before deciding to make a purchase. These are not those goods which customers would buy without giving much thought. Thus I am of the opinion that ordinary customers who exercise reasonable care while making a purchase would notice the differences between the applicant's and the opponent's marks.

The target customer for the applicant's goods are for the general public whereas the target customer for goods bearing the opponent's mark are most likely the public that are already aware of the brand of cars produced by the customers (Rolls Royce). In fact, the product catalogue that was given by the opponent in their statutory declaration (SD) referring to their product as 'promotional merchandise' (exh P). The catalogue also displayed the goods' in Pounds which make it clear that its intended customers are the public in the United Kingdom. The opponent did give annual sales figure for Class 18 (and Class 25) in Malaysia in exh R but in table format but no other supporting documents such as invoices were produced.

The opponent admitted that their products can be found for sale online through two websites; www.exostar.com (for registered user only) and www.4imprint.co.ukrolls-royce (for members of the public). Whereas the trade channel for applicant's goods is their establishment centre inside the Saujana Hotel, Kuala Lumpur. Thus, the trade channel for the applicant's and opponent's goods are also different.

It is clearly stated in the case of *Bata Ltd v Sim Ah Ba* that differences in the trading channels of the parties played an important part in deciding whether the public would be confused by the use of the contending marks. The trade channel for applicant's goods in their entertainment center whereas for the opponent's goods, the goods can be purchased through online. There is a clear distinction between the trade channels of both parties. I am of the view that the public will not be confused or deceived by the use of the contending marks since there is clear differences in trade channel and also the target customers.

Taking into account the differences in the aspect of target customers and the trade channel, I am of the opinion that there is no real tangible risk that the purchasing public would be confused or deceived into believing the goods of the parties come from the same source or wondering whether or not that might be so.

Furthermore, by observing the manner in which the applicant's mark and the opponent's mark is used by looking through the evidence submitted by both parties, I am of the view that use of the marks in their respective and normal fair manner in connection with the goods covered thereof would not cause confusion or deception in the trade and to the public. Therefore, in view of the aforesaid, I have come to the conclusion that the use of the applicant's mark is not likely to deceive or cause confusion to the public. Thus, the opponent had failed in its opposition under ss 19(1) and 14(1)(a) of the Act.

The opponent claimed that the opponent's mark is a well-known mark. I referred to s 14(1)(e):

...

Based on the wording in s 14(1)(e), the vital element here is there must be some kind of evidence that indicate a connection between the applicant's goods and the opponent's goods and the interest of the opponent are likely to be damaged by such use. The wording of s 70B that deals with protection of well-known also stressed on the fact that the use must be likely to deceive or cause confusion.

Based on the evidence tendered by the opponent, I found that the opponent's mark is only well reputed for luxury motor vehicles and not clothing goods. After I considered all the evidences and the principles of trademark law as I have already discussed earlier, I found that there was no evidence that pointed out that the public are likely to be deceived or confused between the applicant's goods and the opponent's goods. I also found that the public will not believe that there exists a connection between the applicant's goods and the opponent's goods. There was also no damage to the interest of the opponent nor any evidence given by the opponent to support that contention. Thus, the opponent had failed in its opposition under ss 14(1)(e) and 70B of the Act.

**[24]** First and foremost it is befitting for me to reproduce the relevant provisions in TMA:

14 Prohibition on registration

(1) A mark or part of a mark shall not be registered as a trade mark —

(a) if the use of which is likely to deceive or cause confusion to the public or would be contrary to law;

(b) if it contains or comprises any scandalous or offensive matter or would otherwise not be entitled to protection by any court of law;

(c) if it contains a matter which in the opinion of the Registrar is or might be prejudicial to the interest or security of the nation;

(d) if it is identical with or so nearly resembles a mark which is well-known in Malaysia for the same goods or services of another proprietor;

(e) if it is well-known and registered in Malaysia for goods or services not the same as to those in respect of which registration is applied for: Provided that the use of the mark in relation to those goods or services would indicate a connection between those goods or services and the proprietor of the well-known mark, and the interests of the proprietor of the well-known mark are likely to be damaged by such use;

(f) if it contains or consists of a geographical indication with respect to goods not originating in the territory indicated, if use of the indication in the mark for such goods in Malaysia is of such a nature as to mislead the public as to the true place of origin of the goods; or

(g) if it is a mark for wines which contains or consists of a geographical indication identifying wines, or is a mark for spirits which contains

or consists of a geographical indication identifying spirits, not originating in the place indicated by the geographical indication in question.

(2) Article 6bis of the Paris Convention and Article 16 of the TRIPS Agreement shall apply for the purpose of determining whether a trade mark is a well-known trade mark.

19 Identical trade marks

(1) No trade mark shall be registered in respect of any goods or description of goods —

(a) that is identical with a trade mark belonging to a different proprietor and entered in the Register in respect of the same goods or description of goods or in respect of services that are closely related to those goods; or

(b) that so nearly resembles such a trade mark as is likely to deceive or cause confusion.

(2) No trade mark shall be registered in respect of any services or description of services —

(a) that is identical with a trade mark belonging to a different proprietor and entered in the Register in respect of the same services or description of services or in respect of goods that are closely related to those services; or

(b) that so nearly resembles such a trade mark as is likely to deceive or cause confusion.

(3) Where separate applications are made by different persons to be registered as proprietors respectively of trade marks which are identical or so nearly resembling each other as are likely to deceive or cause confusion and —

(a) such applications are in respect of the same goods or description of goods; or

(b) at least one of such applications is in respect of goods and the other or others is or are in respect of services closely related to those goods,

the Registrar may refuse to register any of them until their rights have been determined by the Court or have been settled by agreement in a manner approved by him or by the Court.

(4) Where separate applications are made by different persons to be registered as proprietors respectively of trade marks which are identical or so nearly resembling each other as are likely to deceive or cause confusion and —

(a) such applications are in respect of the same services or description of services; or

(b) at least one of such applications is in respect of services and the other

A or others is or are in respect of goods closely related to those services,

the Registrar may refuse to register any of them until their rights have been determined by the Court or have been settled by agreement in a manner approved by him or by the Court.

B 70B Protection of well-known trade marks

(1) The proprietor of a trade mark which is entitled to protection under the Paris Convention or the TRIPS Agreement as a well-known trade mark is entitled to restrain by injunction the use in Malaysia in the course of trade and without the proprietor's consent of the trade mark which, or the essential part of which, is identical with or nearly resembles the proprietor's mark, in respect of the same goods or services, where the use is likely to deceive or cause confusion.

C

(2) Nothing in subsection (1) shall affect the continuation of any bona fide use of a trade mark begun before the commencement of this Act.

D

(3) In this section, references to a trade mark which is entitled to protection under Article 6bis of the Paris Convention or Article 16 of the TRIPS Agreement as a well-known trade mark are to a mark which is well-known in Malaysia as being the mark of a person whether or not that person carries on business, or has any goodwill, in Malaysia, and references to the proprietor of such a mark shall be construed accordingly.

E

Article 6bis of the Paris Convention and article 16 of the TRIPS agreement read as follows:

F

Article 6bis

(1) The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.

G

H

(2) A period of at least five years from the date of registration shall be allowed for requesting the cancellation of such a mark. The countries of the Union may provide for a period within which the prohibition of use must be requested.

I

(3) No time limit shall be fixed for requesting the cancellation or the prohibition of the use of marks registered or used in bad faith.

Article 16 Rights Conferred

1. The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner s consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed. The rights described above shall not prejudice any existing prior rights, nor shall they affect the possibility of Members making rights available on the basis of use.

2. Article 6bis of the Paris Convention (1967) shall apply, mutatis mutandis, to services. In determining whether a trademark is well-known, Members shall take account of the knowledge of the trademark in the relevant sector of the public, including knowledge in the Member concerned which has been obtained as a result of the promotion of the trademark.

3. Article 6bis of the Paris Convention (1967) shall apply, mutatis mutandis, to goods or services which are not similar to those in respect of which a trademark is registered, provided that use of that trademark in relation to those goods or services would indicate a connection between those goods or services and the owner of the registered trademark and provided that the interests of the owner of the registered trademark are likely to be damaged by such use.

**[25]** The learned registrar has in gist found that the impugned mark is confusingly similar to or nearly resembles the mark as a whole. The plaintiffs accepted this finding but the defendant is adamant otherwise and has exhorted me to review the same. I was initially concerned as to whether I am empowered to do so since these are the plaintiffs' appeals. However and after having read the cases of the Federal Court case of *Dato' Seri Anwar Ibrahim v Tun Dr Mahathir bin Mohamad* [2011] 1 MLJ 145 and the Court of Appeal case of *Pentadbir Tanah Daerah Seberang Perai Tengah & Anor v Bagan Serai Housing Estate Sdn Bhd* [2016] 5 MLJ 674; [2016] 8 CLJ 846, I am, by analogy, satisfied that I am able to entertain the defendant's exhortation because the defendant is not seeking to vary the decisions but findings in the grounds of the decisions.

**[26]** In this regard, Mr Bahari Yeow referred to the celebrated Supreme Court case of *Tohtonku Sdn Bhd v Superace (M) Sdn Bhd* [1992] 2 MLJ 63 where Mohamed Yusoff SCJ held therein as follows:

> The 'tests' which Wan Adnan J was referring to were contained in Parker J's judgment in *The Pianotist Co Ltd* in the following terms:
>
> > You must take the two words. You must judge them, both by their look and their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact you must consider all the surrounding circumstances; and you

must further consider what is likely to happen if each of those marks are used in a normal way as a trademark of the goods of the respective owners of the marks.

He also referred to the Federal Court case of *Ho Tack Sien & Ors v Rotta Research Laboratorium SpA & Anor (Registrar of Trade Marks, intervener)* [2015] 4 MLJ 166; [2015] 4 CLJ 20 where Zulkefli Ahmad Makinudin CJ (Malaya) (later PCA) held as follows:

> [29] Further, we are of the view that even if the Registrar gives evidence, the determination of whether there is likelihood of confusion still lies with the court. The question of whether there is a real likelihood of deception of the public is ultimately one for the court to decide as aptly put by Lord Hodson in the case of *Parker-Knoll Limited v Knoll International Limited* [1962] RPC 265 (HC) at p 285 as follows:
>
> > All relevant circumstances must be taken into account, and the question whether or not there is a real likelihood of deception of the public is ultimately for the court and not for the witnesses to decide: see *Spalding & Bros v Gamage Ltd* (1915) 32 RPC 286 per Lord Parker of Waddington: There may, of course, be cases of so doubtful a nature that a judge cannot properly come to a conclusion without evidence directed to the point; but there can be no doubt that in a passing-off action the question whether the matter complained of its calculated to deceive, in other words, whether it amounts to a misrepresentation, is a matter for the judge, who looking at the documents and evidence before him, comes to his own conclusion, and to use the words of *Lord Macnaghtenin Payton & Co Ltd v Snelling, Lampard & Co Ltd* (1990) 17 RPC 635, must not surrender his own independent judgment to any witness whatever.

**[27]** I have accordingly in *Skyworld Development Sdn Bhd & Anor v Skyworld Holdings Sdn Bhd & Ors* [2019] 9 MLJ 137 held that this is an objective test following the Singapore Court of Appeal case of *Tong Guan Food Products Pte Ltd v Hoe Huat Hng Foodstuff Pte Ltd* [1991] 2 MLJ 361; [1991] 3 CLJ 2001 where Yong Pung How CJ held therein as follows:

> The law is settled and there is a series of cases for the following propositions from the last century to the present. The test to be applied has been stated in *Newsweek Inc v British Broadcasting Corp* [1979] RPC 441 at p 447 which is whether ordinary sensible members of the public would be confused. It is not sufficient that the only confusion would be to a very small unobservant section of society or as Foster J put it presently, if the only person who would be misled would be a moron in a hurry. It is sufficient that a substantial proportion of persons who are probably purchasers of the goods of the kind in question would in fact be confused. Whether or not there is misrepresentation is always a question of fact to be determined by the court in the light of evidence of surrounding circumstances. The impression is entirely a matter for the judgment of the court and not that of the witnesses. All that can be done is to ascertain in every case as it occurs whether there is such a resemblance as to

deceive a purchaser using ordinary caution.

It is in other words an objective analysis on a matter of fact and not an exercise of discretion which has to be undertaken by the registrar in the opposition proceedings and likewise by this court in reviewing the registrar's decision on appeal from there.

**[28]** I have punctiliously examined the nature of the mark and impugned mark as a whole following *Illinois Tool Works, Inc v Pendaftar Cap Dagangan (M)* [2009] 9 MLJ 101. Both of them are basically logos. They are not pronounceable words aurally. In my objective opinion, they are significantly dissimilar visually. For ease of reference, they are set out side by side:

| Plaintiff's | Defendant's |
|---|---|
| | |

In the circumstances, I am in agreement with Mr Bahari Yeow that the plaintiffs' mark consists of two alphabets 'RR' which is presumably an abbreviation of Rolls Royce whereas the defendant's impugned mark symbolises the building concept known as 'Rumah Peranakan' and having two alphabets 'RP' within the diamond or rhombus shaped box to symbolise the Peranakan tile concept. The emphasis of both marks is obviously different and they stand out differently too. The difference is even more conspicuous if the coloured version of the defendant's impugned mark is compared with the plaintiff's mark. The 'RR' in the plaintiffs' mark is in my opinion so unique and well recognised to be mistaken. That notwithstanding, the 'RR' and 'RP' alphabets seen in the marks are distinct and plainly distinguishable to me. They would not objectively be resembling each other even viewed through imperfect impression or recollection in line with the cases of *De Cordova v Vick Chemical Co* (1951) 68 RPC 103 and *Tiga Gajah Cho Heng Sdn Bhd v Majuperak Tepung Beras Sdn Bhd* [1997] 4 MLJ 504.

**[29]** So premised, I therefore, with respect, find and hold that the learned registrar had erred in fact in concluding that the defendant's impugned mark looked confusingly similar or nearly resembled the plaintiffs' mark as a whole.

A They are neither identical nor so nearly resembling each other.

**[30]** In having so found that the impugned mark and the mark are dissimilar significantly, there can ipso facto be no cause of confusion or deception to the public. It is accordingly hence unnecessary to analyse the use of the marks as to whether confusion or deception could be so caused too. I will nonetheless briefly deal with it for completeness.

**[31]** The learned registrar basically found that the impugned mark would likely not cause deception or confusion to the consumer notwithstanding her finding that the plaintiffs' mark and the defendant's impugned mark looked confusingly similar as a whole. In this respect, Mr Micheal Soo strenuously disagreed and submitted that the plaintiffs have extensively marketed and offered for sale numerous goods bearing the plaintiffs' mark both in Class 18 and Class 25 via e-commerce in their product catalogues via internet websites. He meticulously took me through them at the hearing and I have no qualms that they were so promoted and sold.

**[32]** However as submitted by Mr Bahari Yeow and found by the learned registrar in her decisions, there is no cogent evidence that these goods were specifically sold in Malaysia at the relevant date of 20 September 2001 when the defendant's applications were filed for registration following *Industria De Diseno Textil, SA v Edition Concept Sdn Bhd* [2005] 3 MLJ 347. It is my opinion that the required cogency necessitated the plaintiffs to substantiate their sales figures as averred in the plaintiffs' affidavits with the relevant sales invoices or delivery notes but this was not done here. This is unlike that as seen in *Abercrombie & Fitch Co & Anor v Fashion Factory Outlet KL Sdn Bhd & Ors* [2008] 4 MLJ 127 where it was found the goods were sold in Malaysia. As to the case of *Midas Ltd v Mister Figgins Pty Ltd* (1987) 9 IPR 569 relied by the plaintiffs, I find that the facts therein are distinguishable in that there was documentary evidence which existed but they were destroyed. The plaintiffs have also not established either first or long and continuous use of the mark on such goods in issue in Malaysia to justify refusal of the registration of the impugned mark following *Fazaruddin bin Ibrahim v Parkson Corp Sdn Bhd* [1997] 4 MLJ 360 and *Caitlin Financial Corp NV v CA Seimer (M) Sdn Bhd & Anor* [2001] 3 MLJ 423 respectively.

**[33]** I am mindful that the plaintiffs have referred to and relied on the cases of *Seven Up Co v OT Ltd* (1947) 75 CLR 203 which was followed in the Court of Appeal case of *Lim Yew Sing v Hummel International Sports & Leisure a/s* [1996] 3 MLJ 7 that a small amount of use is sufficient for the trademark to be identified with and distinctive of the goods of a foreign trader. However the fact remains here that there is no cogent evidence of the use of the mark in goods of Classes 18 and 25 here in Malaysia prior to 20 September 2001. In the

premises, the other cases of *Hermes SA v ET Swift and Co Pty Ltd* (1984) 2 IPR 432, *Buying Systems (Australia) Pty Ltd v Studio SRL* (1995) 30 IPR 517, *Moorgate Tobacco Co Ltd v Philip Morris Ltd and Another* (1984) 56 ALR 193, *Chrysler Corporation v Grundy* (2000) 53 IPR 448 and *Re Registered Trade Mark 'Yanx'; Ex parte Amalgamated Tobacco Corporation Ltd* (1951) 1b IPR 504 relied by the plaintiffs are all distinguishable on their respective peculiar facts.

**[34]** Consequently in the absence of use of the plaintiffs' mark as aforesaid, it is unnecessary for the defendant to establish evidence of its prior use of the defendant's impugned mark contrary to the plaintiffs' contention of such necessity to so prove usage.

**[35]** Be that as it may, the goods involved are branded merchandise. I am satisfied that the customers are discerning ones who are well versed with the respective marks of the parties. These customers would thus be well informed, circumspect and observant following the observations of Ramly J (now FCJ) in *Consitex SA v TCL Marketing Sdn Bhd* [2008] 3 MLJ 574; [2008] 8 CLJ 444. The trade channel of these goods is also obviously different. The defendant's customers will specifically be its hotel guests who would purchase the goods following their stay or accommodation at the defendant's hotel including at its entertainment centre whereas the plaintiffs' affluent customers will seek and purchase their goods from the plaintiffs' presently available websites or perhaps also in their automobile showrooms. It is therefore immaterial that the plaintiffs may have a spill over reputation or goodwill as seen in the cases of *C & A Modes and Anor v C & A (Waterford) Ltd and Ors* [1978] FSR 126, *Dominion Rent A Car Ltd v Budget Rent A Car Systems (1970) Ltd* [1987] 2 NZLR 395 and *Conagra Inc v McCain Foods (Aust) Pty Ltd* (1992) 23 IPR 193 relied by them.

**[36]** In the premises, I do not find that the learned registrar has erred in law and/or in fact because there is no real tangible danger of deception or confusion caused by the co-existence of the defendant's impugned mark and plaintiffs' mark. The case of *Radio Corp Pty Ltd v Disney (Mickey Mouse case)* (1937) 57 CLR 448 on the names 'Mickey Mouse' and 'Minnie Mouse' quoted by the plaintiffs are plainly distinguishable on its facts. This is similar too for the case of *Hasbro Inc v Imagination Holdings Pty Ltd* (2005) 66 IPR 636 on the names 'Livepoly' and 'Monopoly'.

**[37]** Consequently, I hold the plaintiffs' contention that the learned registrar erred in law and/or fact by not refusing the defendant's applications based on s 14(1)(a), (1)(d) and (1)(e) read with s 70B as well as s 19(1) of the TMA is unsustainable because they all hinged upon the impugned mark resembling the mark which would likely deceive or cause confusion; see *Walton International*

*Ltd v Yong Teng Hing (b/s Hong Kong Trading Co)* [2011] 5 MLJ 397; [2010] 8 CLJ 802 and *Hui Kuan Hoe v Societe Des Produits Nestle SA*. Likewise, the plaintiffs' contentions that impugned mark passed off the mark and thus contrary to law based on s 14(1)(a) of the TMA too is equally unsustainable.

**[38]** I am in agreement with the learned registrar that the plaintiff's mark is a well-known mark in respect of luxury motor vehicles in Malaysia following the principles as summarised in *Tokai Corporation v DKSH Malaysia Sdn Bhd* [2016] MLJU 621 and I find that the learned registrar was nonetheless also correct in dismissing the plaintiffs' opposition based on s 14(1)(e) of the TMA because the plaintiffs have not adduced any cogent evidence of damage suffered by them as required by the proviso to s 14(1)(e) of the TMA. The case of *X1R Global Holding Sdn Bhd & Anor v Y-Teq Auto Parts (M) Sdn Bhd* [2016] MLJU 1249 relied by the plaintiffs is hence distinguishable on the facts.

**[39]** Finally, Mr Micheal Soo contended that the applications ought not to be entertained because the impugned mark is not distinctive contrary to s 10 of the TMA which provides as follows:

> 10 Registrable trade marks
>
> (1) In order for a trade mark (other than a certification trade mark) to be registrable, it shall contain or consist of at least one of the following particulars:
>
> (a) the name of an individual, company or firm represented in a special or particular manner;
>
> (b) the signature of the applicant for registration or of some predecessor in his business;
>
> (c) an invented word or words;
>
> (d) a word having no direct reference to the character or quality of the goods or services not being, according to its ordinary meaning, a geographical name or surname; or
>
> (e) any other distinctive mark.
>
> (2) A name, signature or word which is not described in paragraph (1)(a), (b), (c) or (d) is not registrable unless it is by evidence shown to be distinctive.
>
> (2A) For the purposes of this section, 'distinctive', in relation to the trade mark registered or proposed to be registered in respect of goods or services, means the trade mark must be capable of distinguishing goods or services with which the proprietor of the trade mark is or may be connected in the course of trade from goods or services in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered, subject to conditions, amendments, modifications or limitations, in relation to use within the extent of the registration.
>
> (2B) In determining whether a trade mark is capable of distinguishing as aforesaid,

regard may be had to the extent to which —

(a) the trade mark is inherently capable of distinguishing as aforesaid; and

(b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.

(3) A trade mark may be registered in the Register in respect of any goods or services.

**[40]** The learned registrar held as follows in her grounds of decisions on this aspect of distinctiveness:

> Besides that, I am also of the view that the applicant's mark is registrable under s 10 of the Act. As long as the applicant's mark not confusingly similar to the opponent's marks that could lead to any confusion or deception, i have no reason to object the registration of the applicant's mark in Class 18 (Class 25). Thus, the opposition under s 10 of the Act (registrability) has failed.

**[41]** Although not mentioned as to why the impugned mark is registrable by the learned registrar, I have no doubt that it is distinctive pursuant to s 10(1)(e) and (2) of the TMA. In my opinion, the impugned mark is innate and invented by the defendant based on the Peranakan concept as well fanciful, thus inherently distinctive. I have recently held in *Korea Wallpaper Sdn Bhd v Pendaftar Cap Dagangan* [2019] 7 MLJ 549 that it is sufficient as long as the applicant is able to satisfy the registrar that the trademark is registrable within any of the limbs in s 10 of the TMA. That notwithstanding, I am further satisfied that the defendant through its long and continuous use of its impugned mark has acquired substantial goodwill and reputation thereof through its advertisements, marketing and promotion of the goods following *Illinois Tool Works, Inc v Pendaftar Cap Dagangan (M)*. As the result, the impugned mark is also factually distinctive which associated the goods with the defendant.

**[42]** Therefore, I hold that the learned registrar has not erred in law and/or in fact by holding that the impugned mark is registrable contrary to that as asserted by the plaintiffs.

CONCLUSION

**[43]** For the foregoing reasons, I therefore dismiss the appeals with costs of RM5,000 for each appeal subject to 4% allocator.

*Appeals dismissed with cost of RM5,000 for each appeal subject to allocator fee.*

Reported by Izzat Fauzan